

REMARKS

Claims 1-9 are pending in this application. Claims 1 and 9 have been amended by this response. Support for these amendments may be found throughout the specification and specifically on page 3, lines 1-37 and page 4, lines 1-13.

On page 3 of the Office Action, the Examiner makes a request for clarification regarding encoders as described on page 1, 3rd paragraph of the application of the present arrangement. Applicant respectfully submits that the present arrangement can be applied to both encoders that take into account VBI information and those that do not.

Rejection of claims 1-9 under 35 U.S.C. 103(a)

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) (European Patent Application No. EP-1128673) in view of Dean et al. (U.S. Patent No. 5,914,757), hereinafter "Dean" and Isoe et al. (U.S. Patent No. 5,671,019).

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103. Section 2143.03 of the MPEP requires the "consideration" of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely "consider" each and every feature for this claim. Instead, the asserted combination of the patents must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is

nonobvious” (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

The present arrangement provides a video apparatus including a digital encoder receiving a first analogue signal with ancillary information in a given time window and generating, exclusively from the first analogue signal, on an output a digital stream based at least partly on the first analogue signal. A digital decoder at least connectable to the output generates a second analogue signal exclusively from the digital stream at least when being connected to the output. Control means determine the occurrence of the time window and correspondingly generate a control signal. Selecting means selectively output, based on the control signal, the first analogue signal, when the time window occurs, and otherwise, the second analogue signal. The digital decoder includes means for synchronizing the second analogue signal to the first analogue signal.

AAPA describes a video apparatus having a first, second and third circuit. The first circuit generates a first baseband analog video signal on a first output. The second circuit is connectable to the first output and can digitise the first baseband analog video signal and process and output a corresponding digital stream on a second output. The second output is connectable to the third circuit generating on a third output a second baseband analog video signal on the basis of the digital stream (See Abstract).

However, AAPA neither teaches nor suggests “a digital encoder ... generating, exclusively from said first analogue signal ... a digital stream based at least partly on said first analogue signal” or “a digital decoder ... generating a second analogue signal exclusively from said digital stream” as recited in claim 1 of the present arrangement. The Examiner states on page 3 of the Office Action that this rejection is based upon claim 1 not explicitly reciting that the “digital stream” and “second analogue signal” of the present arrangement are generated exclusively from the first signal. In accordance with the Examiner’s comments on page 3 of the Office Action, claim 1 has been amended to explicitly recite that both the digital stream and the second analogue signal are exclusively

generated from the first analogue signal. Specifically, claim 1 has been amended to recite specifically that “a digital stream” is generated “exclusively from said first analogue signal” and “generating a second analogue signal exclusively from said digital stream.” AAPA only describes generation of a digital stream based on a first baseband analog video signal and a second baseband analog video signal based on the digital stream. However, AAPA is silent with regards to generation of the digital stream based exclusively on the first baseband analog video signal and generating the second baseband analog video signal exclusively based on the digital stream. Thus, AAPA neither teaches nor suggests “a digital encoder ... generating, exclusively from said first analog signal ... a digital stream based at least partly on said first analogue signal” or “a digital decoder ... generating a second analogue signal exclusively from said digital stream” as recited in claim 1 of the present arrangement.

The Office Action concedes that AAPA neither discloses nor suggests “control means for determining the occurrence of said time window and correspondingly generating a control signal; selecting means for selectively outputting, based on said control signal, the first analogue signal, when said time window occurs, and otherwise, the second analogue signal” as recited in claim 1 of the present arrangement. However, the Office Action asserts that Dean describes the aforementioned features.

Dean describes a slow Phase Locked Loop (PLL) that is utilized to prevent an abrupt change to a video display containing multiple images, when the source of the synchronization is changed. Such displays include Picture in Picture (PIP) television systems and computer displays. By appropriate buffering and memory management, visual disruptions can be minimized by slowly synchronizing the display synchronization signals to the new synchronization source. The slow synchronization also produces a less disruptive visual image when the source, or channel, of a single image display is changed, and allows for smooth visual transitions on displays having inertial elements, such as color wheels (see col. 3, lines 44-59).

Dean, like AAPA, also neither teaches nor suggests “selecting means for selectively outputting, based on said control signal, the first analogue signal, when said time window occurs, and otherwise, the second analogue signal” as recited in claim 1 of the present arrangement. Dean describes outputting a synchronization signal 102 to the video display 100. Additionally, the output of mixer 150 is connected to the video display 100. Dean does not use a “time window” to determine when to “selectively” output a signal. Therefore, Dean neither teaches nor suggests “selecting means for selectively outputting, based on said control signal, the first analogue signal, when said time window occurs, and otherwise, the second analogue signal” as recited in claim 1 of the present arrangement.

In addition, Dean, like AAPA, neither teaches nor suggests “a digital encoder ... generating, exclusively from said first analogue signal ... a digital stream based at least partly on said first analogue signal” or “a digital decoder ... generating a second analogue signal exclusively from said digital stream” as recited in claim 1 of the present arrangement.

The Office Action argues that modifying AAPA and Dean with Isoe would result in a system where “the digital decoder includes means for synchronising the second analogue signal to the first analogue signal” as recited in claim 1 of the present arrangement. Applicant respectfully disagrees.

Isoe describes a display apparatus for displaying a partial-screen image within a full-screen image including a change-over switch for exchanging the video signals for the full-screen and partial-screen displays. When only the full-screen image is displayed, character information corresponding to the full-screen image can be turned on or off. When both the full-screen image and the partial-screen image are displayed, a cyclic operation can be performed under control of a controller. The cycle includes: 1) turning on the display of character information corresponding to the full-screen image, 2) turning on the display of character information corresponding to the partial-screen image, and 3)

turning off the display of character information. The display apparatus is also capable of turning on the display of character information corresponding to the full-screen image when a mute of sound is turned on and turning off the display of character information when the mute of sound is subsequently turned off. (See col. 3, lines 38-67, col. 4, lines 1-67, and col. 5, lines 1-36)

Isoe, like AAPA and Dean, neither teaches nor suggests that “the digital decoder includes means for synchronising the second analogue signal to the first analogue signal” as recited in claim 1 of the present arrangement. Isoe describes a system supporting switching between a main signal and a second signal. Figure 4B shows an example of a main signal displayed with a caption for a second signal also displayed. However, this is not the same as “synchronising the second analogue signal to the first analogue signal.” Simply displaying two signals simultaneously is not the same as “synchronising” the signals based on a time window. Furthermore, Applicant respectfully asserts that the Office Action provides an incomplete argument regarding Isoe because on the fourth paragraph of page 4 of the Office Action, the sentence is incomplete and does not state how Isoe describes that “the digital decoder includes means for synchronising the second analogue signal to the first analogue signal.” Thus, Isoe, like AAPA and Dean, neither teaches nor suggests that “the digital decoder includes means for synchronising the second analogue signal to the first analogue signal” as recited in claim 1 of the present arrangement.

In addition, Isoe, like AAPA and Dean, also neither teaches nor suggests “a digital encoder ... generating, exclusively from said first analogue signal ... a digital stream based at least partly on said first analogue signal” or “a digital decoder ... generating a second analogue signal exclusively from said digital stream” as recited in claim 1 of the present arrangement.

A combination of AAPA, Dean and Isoe, similar to the individual systems, also neither teaches nor suggests the aforementioned features of amended claim 1 of the present

arrangement. The combination of AAPA, Dean and Isoe, would yield a system containing a digital decoder that would receive an analog signal and output a digital signal. The system would also have the ability to display a main signal and a caption from another signal on a display. A second analog signal may also be converted to a digital signal through an A/D converter. The two signals may be synchronized with one another. However, synchronization could only occur after the signals are converted to digital. The combined system, similar to the individual systems, would not teach or suggest “a digital encoder receiving a first analogue signal with ancillary information in a given time window and generating, exclusively from said first analogue signal, on an output a digital stream based at least partly on the first analogue signal” as recited in claim 1 of the present arrangement. The combined system, similar to the individual systems, also would not teach or suggest “a digital decoder ... generating a second analogue signal exclusively from said digital stream” as recited in claim 1 of the present arrangement. Additionally, the combined system would not teach or suggest “selecting means for selectively outputting, based on said control signal, the first analogue signal, when said time window occurs, and otherwise, the second analogue signal.” Moreover, although the combined system may describe a digital decoder, the digital decoder would not be able to synchronize “the second analogue signal to the first analogue signal” as the combined system only synchronizes two digital signals after the signals are converted from analog to digital. Therefore, the combined system of AAPA, Dean and Isoe, similar to the individual systems, neither teaches nor suggests the features of amended claim 1 of the present arrangement. Therefore, it is respectfully submitted that the rejection of claim 1 is satisfied and should be withdrawn.

Claims 2-8 are dependent on claim 1 and are considered patentable for the reasons set forth above regarding claim 1. Therefore, it is respectfully submitted that the rejection of claims 2-8 is satisfied and should be withdrawn.

Independent claim 9 contains features similar to those found in claim 1 and is considered patentable for the reasons set forth above regarding claim 1. Therefore, it is respectfully submitted that the rejection of claim 9 is satisfied and should be withdrawn.

Having fully addressed the Examiner's rejections, it is believed that, in view of the preceding amendments and remarks, this application stands in condition for allowance. Accordingly then, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the applicant's attorney at the phone number below, so that a mutually convenient date and time for a telephonic interview may be scheduled.

No other fee is believed due. However, if an additional fee is due, please charge the fee to Deposit Account 07-0832.

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